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EXAMINER

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Continuation sheet:

Continuation of 5. The amendment to Claim 1 removes the limitation that caused the rejection under 35 U.S.C. 112, 1st paragraph and returns the claim language to that in the amendment submitted 3/10/2010, thus includes only limitations previously claimed. The indicated rejection has been withdrawn.

Continuation of 7: Note that the Office Action Summary for the Final Office Action mailed 9/27/2010 indicated Claim 10 as being rejected. However, as indicated in the body of the Office Action, Claim 10 is only objected to as being dependent upon a rejected base claim. The statement of rejected claims in this Advisory Action has been corrected to show that Claim 10 is objected to and not rejected.

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments have been fully considered but they are not persuasive.

Applicant argues that:

- a. Kaule et al only discloses the use of curing compositions and there is no suggestion to use a physically drying liquid lacquer layer (p 15, 2nd to 4th pars);
- b. A physically drying liquid lacquer layer will not cure (i.e.-will not polymerize or cross-link) (p 15, 5th par) and will not be "largely homogeneous chemically" to a lacquer or adhesive that cures..as is required of the Kaule patent;
- c. All of the compositions in the Gertzmann patent are curable, i.e. polymerizes or cross-links, irreversibly (p 16, 1st - 3rd pars);

d. The interpretation that a hybrid composition that includes some physical drying followed by some sort of curing reads on “a physically drying liquid lacquer layer” is inconsistent with the specification as originally filed and is inconsistent with the understanding of a person having ordinary skill in the art (pp 16-19). Several paragraphs in the specification are cited in support. In addition, an excerpt from “Handbook of Print Media” is included to show that there is a distinction between drying effected by 1) chemical reaction, 2) physical processes, and 3) a combination of both (i.e. hybrid).

Regarding points a to c, the statement that a physically drying liquid lacquer layer will not cure is the argument of counsel and cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); In re Geisler, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) (“An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness.”). In addition, as discussed in the outstanding rejections, Gertzmann et al discloses compositions that form films that are physically dried and may be (but are not required to be) further irradiated with UV light (presumably cured) (col 11, lines 31-42). Gertzmann et al thus indicates that the curing may be effected by UV radiation, or by drying and heating.

Regarding point d, the cited paragraphs do not define “a physically drying liquid lacquer layer” and do not prohibit such layer from also being cured as well as physically

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dried. Paragraph 7 discusses prior art. Paragraphs 10 and 11 discuss closing depressions, uneven layers and pores of substrates with a physically drying lacquer layer, but do not state that the layer cannot be cured. Paragraph 13 discuss using a lower layer with cotton paper of security and value documents, does not state that the layer is a physically drying liquid lacquer layer that cannot be cured. Paragraph 14, stated by Applicants as discussing the lower layer in detail, makes no reference to a radiation or chemically curing layer, and also no reference to a physically drying liquid lacquer layer. Paragraphs 15 and 19 discuss the upper lacquer layer. Paragraphs 39, 40 and 48 discuss two layers, but do not state that the lower layer is a physically drying liquid lacquer layer that cannot be cured.

The Handbook of Print Media discusses different methods of drying printing ink, including physical processes, chemical reaction and combinations of both. Even if the description of the methods is applicable to non-ink technologies such as coating compositions, the discussion does not define the claimed “physically drying liquid lacquer layer” and does not prohibit such layer from also being cured as well as physically dried. The claimed species of the second upper layer, which is formed from a radiation-curing UV-crosslinked layer, a physically-drying layer or a hybrid lacquer layer containing both physically drying components and a radiation-curing lacquer component, fail to define a “physically drying liquid lacquer layer” or prohibit such layer from also being cured as well as physically dried.

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The outstanding rejections are maintained. Any modification required to address the current claims would pertain only to the deleted limitation, "without a radiation-curing lacquer component."

/Dennis Cordray/

Examiner, Art Unit 1741

/Matthew J. Daniels/

Supervisory Patent Examiner, Art Unit 1741